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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appln. No. 10/739,206)
First Named Applicant: SHARON D. PATRICK)
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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 CFR §1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on June 28, 2005.

The fees required under 37 CFR §1.17(c), and are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 CFR §1.192(a))

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This brief contains these items under the following headings, and in the order set forth below (37 CFR §1.192(c)):

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The final page of this brief bears the practitioner's signature.

I. REAL PARTIES IN INTEREST - 37 CFR §1.192(c)(1)(i)

The real parties in interest in this appeal are the applicant Sharon D. Patrick.

II. RELATED APPEALS AND INTERFERENCES - 37 CFR §1.192(c)(1)(ii)

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS - 37 CFR §1.192(c)(1)(iii)

On June 28, 2005, appellant appealed from the final rejection of claims 1, 3 through 12, and 15 through 21, all of which remain pending in the application.

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 18 claims

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 2 and 13 through 14
2. Claims withdrawn from consideration but not canceled: (none)
3. Claims pending: claims 1, 3 through 12, and 15 through 21
4. Claims allowed: (none)
5. Claims rejected: claims 1, 3 through 12, and 15 through 21

C. CLAIMS ON APPEAL

The claims on appeal are: claims 1, 3 through 12, and 15 through 21.

IV. STATUS OF AMENDMENTS - 37 CFR §1.192(c)(1)(iv)

Claims 1 through 15 were originally filed in the subject patent application. In the first Amendment of the subject application, filed September 8, 2004, claims 1, 12, and 15 were amended, claims 13 and 14 were cancelled, and claims 16 through 21 were added. In the second Amendment of the subject application, filed February 1, 2005, claims 1, 15, 16, and 18 were amended and claim 2 was cancelled. No amendments of the claims were requested after the final Office Action was mailed on April 8, 2005. However, below in the Appendix, the dependency of claims 3 through 6 have been amended so that they do not depend from cancelled claim 2.

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 CFR §1.192(c)(1)(v)

The invention comprises a tissue box holding device 10 that comprises a panel 12 (see FIG. 3) which has a rear edge 14, a forward edge 16 and a pair of lateral side edges 18. The panel 12 has a width from the rear edge 14 to the forward edge 16 generally between 1 inch and 2 inches, and has a length between the side edges 18 generally between 4 inches and 10 inches.

The device 10 includes a pair of legs 20, and each of the legs has a lower end 22 that is attached to and extends upwardly from the rear edge 14 of the panel 12. The legs 20 are spaced from each other such that each of the legs is positioned adjacent to one of the side edges 18. Each of the legs 20 is positioned in a plane orientated substantially perpendicular to a plane of the panel 12. Each of the legs 20 has a height generally between 4 inches and 5 inches, and each of the legs 20 has an outer edge 26.

The device 10 includes a bracket 30 (see FIG. 3) attached to the legs 20 and extending over the panel such that a plane of the bracket is orientated substantially parallel to the plane of the panel 12. The bracket 30 includes an elongated member 32 and a pair of arms 34 that are attached to and extend away from opposite ends of the elongated member. The arms 34 are orientated perpendicular to the elongated member 32. Each of the arms has a free end 36 with respect to the elongated member 32, and each of the free ends is attached to one of the legs 20. Each of the free ends 36 is positioned adjacent to a respective one of the outer edges 26 of the legs 20. The elongated member 32 has a length that is substantially equal to the length of the panel 12.

The device includes a coupler 38 that is attached to an upper end 24 of the legs 20 for selectively coupling the legs to a vertical surface. A brace is attached to and extends between the legs 20. The device 10 is configured so that a tissue holding box may be removably positioned on the panel 12 and held against the legs 20 by the bracket 30.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL - 37 CFR §1.192(c)(1)(vi)

A. Claims 1 and 3 through 10 stand rejected under U.S.C. §103(a) as being unpatentable over Berlin.

B. Claims 11, 12, and 15 through 21 stand rejected under U.S.C. §103(a) as being unpatentable over Berlin as applied to claims 1, 2, 6 and 9 through 11 (sic--1 and 3 through 10) and further view of May.

VII. ARGUMENT - 37 CFR §1.192(c)(1)(vii)

A. Group I: Claims 1 and 3 through 10

Claim 1 requires, in part, “a panel, said panel having a rear edge, a forward edge and a pair of lateral side edges, said panel having a width from said rear edge to said forward edge generally between 1 inch and 2 inches”. This requirement of the claims is submitted to provide a highly effective size for holding a tissue box, which is the intended purpose of the invention of the present application.

Turning to the “Response to Arguments” in the final Office Action, it is alleged that:

The applicant has argued that the dimensions cited above are not within the "workable" range of the device as intended. This is unpersuasive in that the child's seat maybe dimensioned an any size, including the dimensions as listed above. This would not destroy the intended purpose of the device in that it may be used for a toy doll which represents a human child, which would require small dimensions such as those listed above. Therefore, this argument is unpersuasive.

However, while it may be possible to “dimension” a child’s seat in “any size”, that does not make “any” and all sizes of the child’s chair disclosed in Berlin an “obvious” modification of the Berlin disclosure within the meaning of the law on obviousness.

Clearly, the Berlin disclosure is directed to and concerns a child’s chair in which a child is to be seated. As previously noted, modification of the Berlin structure to meet the requirements of claim 1 would make it unable to receive a child and thus unusable as a child chair, and thus such a change to Berlin would not be obvious to one of ordinary skill in the art. In other words, one of ordinary skill in the art would not be motivated, or find it obvious, to modify the structure of Berlin in a manner that would make it unusable as a child’s chair, which is its

primary and sole purpose. The Berlin patent does not disclose any other uses or applications for the child's chair bracket suspension, so clearly one of ordinary skill in the art could not glean from Berlin any other uses for the apparatus.

Claim 1 further requires "wherein a tissue holding box may be removably positioned on said panel and held against said legs by said bracket".

It is further contended in the rejection of the claims in the Office Action that:

Berlin also teaches the method of placing a device on the panel, but doesn't say that the device positioned on the panel is a tissue box. It would be obvious to one of ordinary skill in the art to have placed any easily carried item within the carrying device as taught by Berlin, the method of placing something on the panel which is taught by Berlin.

However, contrary to this allegation in the Office Action, it is submitted that simply because one might be of the opinion that the "Child's Chair Bracket Suspension" of the Berlin patent could be capable of holding "any easily carried item", as asserted in the Office Action, that does not make the combination of the child's chair bracket suspension of Berlin with any other item inherently obvious, as apparently contended in the Office Action. Berlin describes a child's chair bracket suspension device, which does not suggest to one of ordinary skill in the art that "any easily carried item" could or should be supported by the disclosed bracket suspension device. Particularly, the Berlin patent is fairly clear as to the use and advantage of its "chair suspension bracket", as evidenced in Berlin at col. 1, lines 7 through 10 (emphasis added):

My invention relates to a child's chair bracket suspension, and more particularly relates to a bracket for suspending the usual auxiliary automobile seat for children firmly and securely upon the back of a house chair.

And also at col. 1, lines 21 through 29 (emphasis added):

The invention set forth herein is adapted to support and secure small children from the time that they are just able to sit up upright until they are three or four years old. The invention is further adapted to restrain the child in a sitting or standing position and to provide fairly substantial support for the child, should the child elect to sit down when the seat is in the lowered position either upon the back of an automobile seat or upon a conventional household chair.

Thus, one of ordinary skill in the art, considering the actual teaching of the Berlin patent, is led to understand that the device described in the Berlin patent is useful for suspending a child and a child's automobile seat from a house chair, and not to understand that virtually anything could be supported by the chair suspension bracket. Furthermore, it is submitted that one of ordinary skill in the art does not recognize a need or desire to be able to suspend a tissue box from the back rest of a house chair, particularly using the suspension bracket device that is specifically disclosed for a chair.

Further, merely because it may be possible to make the Berlin child's chair bracket suspension of any size does not make it obvious. A mere possibility based on conjecture does not establish a *prima facie* case of obviousness or anticipation based on a reference which is completely silent with regard to the allegedly possible functionality. Therefore, in accordance with In re Warner and Warner, which says that the Patent Office cannot "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis" (154 USPQ 173, 178, emphasis added), it is inappropriate to rely on speculation, conjecture or an allegedly possible functionality to reject the present claims.

It is therefore submitted that one of ordinary skill in the art would not be led to alter the child's chair bracket suspension of the Berlin

patent to be capable of receiving a tissue box “removably positioned on said panel and against said legs by said bracket”, as required by claim 1.

B. Group II: Claims 11, 12, and 15 through 21

Claim 11, which depends from claim 1, requires “a support being attached to and extending between said vertical portions of said hooks”.

With respect to this requirement, it is contended in the Office Action that:

Berlin also discloses that the coupler (50, 52) includes a pair of hooks attached to the legs and extending in an opposite direction than the bracket (4B), the hooks having a horizontal portion and a downwardly extending vertical portion spaced from the legs.

It is conceded in the final Office Action that:

Berlin does not show a support attached to and extending between the vertical portion of the hooks, the support having at least two apertures/holes and screws extending therethrough, each aperture having an axis orientated perpendicular to the plane of the legs.

It is then alleged in the final Office Action that

May teaches a device with a pair of legs (22) and a pair of hooks (23) with a vertical portion that teaches a support attached extending between the vertical portion of the hooks, the support (24) having at least two apertures/holes (near 25) and screws (25) extending therethrough, each aperture having an axis orientated perpendicular to the plane of the legs (22), the apertured support used so that further support may be added to the device when it is attached to the vertical surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of May to have added this apertured support, in order to add further support to the device and to make it sturdier.

However, it is submitted that one of ordinary skill in the art, considering the Berlin patent and its teaching, would not be led to this allegedly obvious modification of the Berlin structure using the “back bar 24” of

the May patent. More particularly, the hooks 50, 52 of Berlin are designed and intended to pivot inwardly and outwardly between storage and operational positions. See Berlin at col. 2, lines 38 through 57:

As is apparent from the foregoing description, my invention is used in the following manner: Referring to FIG. 1, the seat is adapted to be used on the back of an automobile by employing the hooks 50 and 52 (solid lines) at right angles to the plane of the back rest portion 40. When the seat B is used as a high chair, the arms 50 and 52 are rotated inwardly (broken lines) substantially coplanar with the back rest portion 40. The bracket suspension A is mounted upon the hook 50 or 52 by turning the bracket until the leg portion of the hooks fit intermediate the surfaces 39 and 32 of the tabs 25 of the fingers C1 and C2 respectively. The bracket A is then rotated until the leg portion of the hooks is substantially aligned with the arm 12 and the lip 54 sits in the leg 18 intermediate the upwardly projecting edges 22 and 24 respectively. By hooking the bight portion 16 upon the back of a chair, it is easily seen that the auxiliary automobile seat is convertible into a high chair and securely supported for maintaining the child securely in position either in a sitting or standing position.

Thus, the pivotability of the hooks 50, 52 of the Berlin structure is critical, and it is submitted that any attempt to merge the back bar 24 of May into the hooks of Berlin would eliminate this functionality of Berlin. It is therefore submitted that one of ordinary skill in the art would not alter the hooks of Berlin in the manner alleged in the Office Action as this would destroy this important functionality of the Berlin structure, and that the obviousness rejection of claim 11 based upon the asserted combination of Berlin and May cannot stand.

Further, claim 15 requires "a coupler being attached to *an upper end of said legs* for selectively coupling said legs to a vertical surface", and claim 20 requires "providing a coupler being attached to *an upper end of said legs* for selectively coupling said legs to a vertical surface" (emphasis added). It is submitted that, assuming that one of ordinary skill in the art would look to the May patent when considering the Berlin patent, would not be led to the coupler as required by claims 15 and 20 as

the back bar 24 of the May patent is not located at an upper end of the shoulder straps 23 of the May structure, but in a lower position than an upper end. Further, despite the suggestion in the Office Action, the May patent does not provide any basis for one of ordinary skill in the art to understand “from the teachings of May [that] this apertured support [would] add further support to the [Berlin] device and to make it sturdier.” Such a suggestion is not found any where in the May patent, and in fact the May patent is silent as to the purpose of the back bar.

Still further, in order to provide a prima facie case of obviousness, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action states that the motivation to combine May with Berlin is “in order to add further support to the device and to make it sturdier.” It is respectfully submitted that given the actual teachings of the references, the cited motivation to combine is not found in the references themselves. The Berlin patent discusses a child’s chair bracket suspension for mounting child seat on a house chair, while the May patent discusses a carrier assembly for percussion instruments for carrying drums on the body of a person, and there is no discussion in the Office Action why one of ordinary skill in the art would understand that a feature of a drum support would be beneficial to a child seat bracket. The cited references do not make any such statements regarding this, and it is respectfully submitted that the quoted statement from the Office Action is merely a conclusory statement of belief and not specific objective evidence of a motivation to combine.

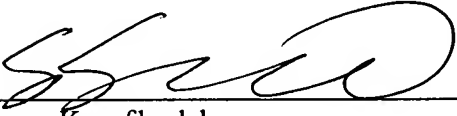
C. Conclusion

Withdrawal of the §103(a) rejection of claims 1 and 3 through 10 is therefore respectfully requested, and an indication of the allowability of claims 1 and 3 through 10 is also requested.

Also, withdrawal of the §103(a) rejection of claims 11, 12, and 15 through 21 is therefore respectfully requested and allowability of these claims also solicited.

For the foregoing reasons, appellant believes that the Examiner's rejections of claims 1 through 14 are erroneous, and reversal of the rejections is respectfully requested.

Respectfully submitted,



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VIII. CLAIMS APPENDIX - 37 CFR §1.192(c)(1)(viii)

The text of the claims involved in the appeal is as follows:

1. (previously presented) A tissue box holding device comprising:
 - a panel, said panel having a rear edge, a forward edge and a pair of lateral side edges, said panel having a width from said rear edge to said forward edge generally between 1 inch and 2 inches;
 - a pair of legs, each of said legs having a lower end being attached to and extending upwardly from said rear edge, said legs being spaced from each other such that each of said legs is positioned adjacent to one of said side edges, each of said legs being positioned in a plane orientated substantially perpendicular to a plane of said panel;
 - a brace being attached to and extending between said legs;
 - a bracket being attached to said legs and extending over said panel such that a plane of said bracket is orientated substantially parallel to said plane of said panel;
 - a coupler being attached to an upper end of said legs for selectively coupling said legs to a vertical surface; and
 - wherein a tissue holding box may be removably positioned on said panel and held against said legs by said bracket.
2. (cancelled)
3. (currently amended) The device according to claim [[[2]]] 1, wherein said panel has a length between said side edges generally between 4 inches and 5 inches.

4. (currently amended) The device according to claim [[[2]]] 1, wherein said panel has a length between said side edges generally between 9 inches and 10 inches.

5. (currently amended) The device according to claim [[[2]]] 1, wherein each of said legs has a height generally between 4 inches and 5 inches.

6. (currently amended) The device according to claim [[[2]]] 1, wherein said bracket includes an elongated member and a pair of arms being attached to and extending away from opposite ends of said elongated member, said arms being orientated perpendicular to said elongated member, each of said arms having a free end with respect to said elongated member, each of said free ends being attached to one of said legs.

7. (original) The device according to claim 6, wherein each of said legs has an outer edge with respect to each other, each of said free ends being positioned adjacent to a respective one of said outer edges of said legs.

8. (original) The device according to claim 6, wherein said elongated member has a length substantially equal to said length of said panel.

9. (original) The device according to claim 6, wherein said coupler includes a pair of hooks, each of said hooks being attached to one of said legs, each of said hooks extending in a direction opposite of said bracket.

10. (original) The device according to claim 9, wherein each of said hooks includes a horizontal portion attached to said legs and a downwardly extending vertical portion spaced from said legs.

11. (original) The device according to claim 10, further including a support being attached to and extending between said vertical portions of said hooks.

12. (previously presented) The device according to claim 11, wherein said support has at least two apertures extending therethrough, each of said apertures having an axis orientated perpendicular to said plane of said legs, said apertures being spaced from said hooks.

13. (cancelled)

14. (cancelled)

15. (previously presented) A tissue box holding device comprising:

a panel, said panel having a rear edge, a forward edge and a pair of lateral side edges, said panel having a width from said rear edge to said forward edge generally between 1 inch and 2 inches, said panel having a length between said side edges generally between 4 inches and 10 inches;

a pair of legs, each of said legs having a lower end being attached to and extending upwardly from said rear edge, said legs being spaced from each other such that each of said legs is positioned adjacent to one of said side edges, each of said legs being positioned in a plane orientated substantially perpendicular to a plane of said panel, each of said legs having a height generally between 4 inches and 5 inches, each of said legs having an outer edge with respect to each other;

a bracket being attached to said legs and extending over said panel such that a plane of said bracket is orientated substantially parallel to said plane of said panel, said bracket including an elongated member and a pair of arms being attached to and extending away from opposite ends of said elongated member, said arms being orientated perpendicular to said elongated member, each of said arms having a free end with respect to said elongated member, each of said free ends being attached to one of said legs, each of said free ends being positioned adjacent to a respective one of said outer edges of said legs, said elongated member having a length substantially equal to said length of said panel;

a coupler being attached to an upper end of said legs for selectively coupling said legs to a vertical surface;

a brace being attached to and extending between said legs; and

wherein a tissue holding box may be removably positioned on said panel and held against said legs by said bracket.

16. (previously presented) The tissue box holding device according to claim 15, wherein said coupler includes a pair of screws each being removably extendable through a hole in each of said legs and into the vertical surface.

17. (previously presented) The tissue box holding device according to claim 15, wherein said coupler including a pair of hooks, each of said hooks being attached to one of said legs, each of said hooks extending in a direction opposite of said bracket, each of said hooks including a horizontal portion attached to said legs and a downwardly extending vertical portion spaced from said legs, a support being attached to and extending between said vertical portions of said hooks, said support having at least two apertures extending therethrough, each of said

apertures having an axis orientated perpendicular to said plane of said legs, each of said apertures being spaced from said legs.

18. (previously presented) A method of holding a tissue box comprising the steps of:

providing a panel having a rear edge, a forward edge and a pair of lateral side edges, said panel having a width from said rear edge to said forward edge generally between 1 inch and 2 inches;

providing a pair of legs, each of said legs having a lower end being attached to and extending upwardly from said rear edge, said legs being spaced from each other such that each of said legs is positioned adjacent to one of said side edges, each of said legs being positioned in a plane orientated substantially perpendicular to a plane of said panel, each of said legs having an outer edge with respect to each other;

providing a bracket being attached to said legs and extending over said panel such that a plane of said bracket is orientated substantially parallel to said plane of said panel, said bracket including an elongated member and a pair of arms being attached to and extending away from opposite ends of said elongated member, said arms being orientated perpendicular to said elongated member, each of said arms having a free end with respect to said elongated member, each of said free ends being attached to one of said legs, each of said free ends being positioned adjacent to a respective one of said outer edges of said legs, said elongated member having a length substantially equal to said length of said panel;

providing a coupler being attached to an upper end of said legs for selectively coupling said legs to a vertical surface;

providing a brace being attached to and extending between said legs;
positioning a tissue box on said panel such that said brace extends around said tissue box; and
attaching said upper ends of said legs to a vertical surface with said coupler.

19. (previously presented) The method according to claim 18, wherein said coupler includes a pair of hooks, each of said hooks being attached to one of said legs, each of said hooks extending in a direction opposite of said bracket, each of said hooks including a horizontal portion attached to said legs and a downwardly extending vertical portion spaced from said hooks.

20. (previously presented) The method according to claim 19, wherein said coupler further includes a support being attached to and extending between said vertical portions of said hooks, said support having at least two apertures extending therethrough, each of said apertures having an axis orientated perpendicular to said plane of said legs, each of a pair of screws being extended through one of said apertures in said support and into said vertical surface.

21. (previously presented) The method according to claim 18, wherein said coupler includes a pair of screws, each of said screws being selectively extended through one of a pair of holes in said legs such that said legs are attached to the vertical surface.

IX. EVIDENCE APPENDIX - 37 CFR §1.192(c)(1)(ix)

No such evidence under 37 CFR 1.130, 37 CFR 1.131, 37 CFR 1.132 or other evidence was submitted or relied upon during the prosecution of this application.

X. RELATED PROCEEDINGS APPENDIX - 37 CFR §1.192(c)(1)(x)

None.